IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Kazuma AOKI et al.   Group Art Unit: 2625

Application No.:   10/759,007   Examiner: K. YIP

Filed: January 20, 2004   Docket No.:   118331

For: COMMUNICATION SYSTEM

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Claims 1-8, 10-18, 20 and 23-27 are pending in this application. In reply to the

August 20, 2009 Office Action, Applicants respectfully request reconsideration and prompt

allowance of the pending claims at least in light of the following remarks.

The courtesies extended to Applicants' representative by Examiner Yip and

Supervisory Patent Examiner Haskins at the interview held November 5, are appreciated.

The reasons presented at the interview are incorporated into the remarks below, which

constitute Applicants' record of the interview

Claims 1, 6-8, 14-18, 20 and 23-27 are rejected under 35 U.S.C.§ 103(a) as being

unpatentable over U.S. Patent No. 7,289,685 (Wolff) in view of U.S. Patent Publication No.

2002/0194219 (Bradley). Applicants respectfully traverse the rejection.

In particular, as discussed at the interview, Wolff and Bradley, either alone or in combination, fail to disclose or to have rendered obvious a determination unit that determines whether the accessed web page includes an input field, as recited in claims 1, 8, 16, 17, 18 and 20. The Office Action admits that Wolff does not disclose this feature. To make up for the deficiency, the Office Action asserts that paragraphs [0066] and [0074]-[0083] of Bradley disclose this feature and that it would have been obvious to the skilled artisan to have implemented the teachings of Bradley into Wolff. Applicants believe that this rejection is improper for at least the following two reasons.

First, Bradley fails to expressly disclose the above claimed feature. Bradley discloses systems and methods of creating and deploying electronic forms for collecting information from a user using a browser (Abstract). Paragraphs [0074]-[0083] of Bradley disclose a toolbox to design a form that provides users with information and allows them to enter data (paragraph [0073]). Bradley discloses that by using the toolbox, a designer can design places to enter data, predefine the format of the field such as standardizing the appearance of a telephone number, and create buttons and check boxes which enable the users to select one of several options (paragraphs [0074]-[0083]). Bradley also discloses that forms created can be accessed via the Internet or an intranet from a wide range of Web browsers (paragraph [0066]). However, paragraphs [0066] and [0074]-[0083] of Bradley do not disclose that it is determined whether the form has the input filed when the form is accessed. Thus, as the Office Action admits (the Office action on page 4), paragraphs [0066] and [0074]-[0083] of Bradley fails to expressly disclose above claimed feature.

The remaining disclosure of Bradley is also silent about the above claimed feature. For example, Bradley discloses that from a single template, the server determines the browser type and then transforms the form template into a format that best suits that particular browser type (paragraph [0064]). Bradley also discloses that end users access the Server to retrieve an

offline form package containing a form and that the server transforms the form into an offline package that contains all pages in the form (paragraph [0057]). Bradley further discloses that the Server determines the platform and browser prior to creating the package and will send the package associated to their platform/browser (*Id.*). However, Bradley fails to disclose that it is determined whether the form includes the input filed when the form is accessed. Thus, Bradley fails to expressly disclose above claimed feature.

Second, Bradley fails to inherently disclose the above claimed feature. The Office Action asserts that paragraphs [0066] and [0074]-[0083] of Bradley inherently disclose the above claimed feature alleging "if the browser can access an internet form, it inherently can determine what the content of the form is" (the Office Action on page 4). Applicants believe this interpretation is improper.

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is <u>necessarily present</u> in the thing described in the reference, and that it would be so recognized by persons of ordinary skill (MPEP §2112). Inherency, however, may not be established by probabilities or possibilities (*Id.*). The mere fact that a certain thing may result from a given set of circumstances is not sufficient (*Id*). In the present case, the Examiner does not provide any extrinsic evidence proving that the above claimed feature is <u>necessarily</u> present in paragraphs[0066] and [0074]-[0083]. Just because a program can access a web page does not <u>necessarily</u> mean it can determine the content of the form. For example, as Fig. 2 of the present invention shows, accessing the web page (step S110) is a different step of determining the content of the web page (S140). Because the Examiner does not provide the extrinsic evidence that must make clear that the above claimed feature is necessary present and it could represent something other than claimed feature, paragraphs [0066] and [0074]-[00830] do not inherently disclose the above claimed feature.

Thus, Bradley fails to disclose a determination unit that determines whether the accessed web page includes an input field, as recited in claims 1, 8, 16, 17, 18 and 20.

Accordingly, Wolff and Bradley, either alone or in combination, fail to disclose or to have rendered obvious the above claimed feature.

Further, as discussed at the interview, Wolff and Bradley fail to disclose or to have rendered obvious the second print controller which controls the printing unit to print an image data having a fill-in area corresponding to the input field when the determination unit determined that the web page includes the input field, as recited in claims 1, 8, 16, 17, 18 and 20. The Office Action admits that Wolff fails to disclose this feature. To make up for the deficiency, the Office Action asserts that paragraph [0051] of Bradley discloses this feature and that it would have been obvious to the skilled artisan to have implemented the teachings of Bradley into Wolff. Applicants believe that this rejection is improper for at least the following reasons.

Bradley fails to make up for the deficiency of Wolff. Bradley discloses that <u>to allow end-users to print</u>, the Server can convert the template to another format suitable for printing (paragraph [0051]). Bradley also discloses that unlike with ordinary HTML forms that print using the Web browser, enterprises can precisely control the layout and pagination of these forms (*id.*). Bradley further discloses that <u>users can therefore print their filed-out forms</u> (*id.*). However, Bradley fails to disclose that printing is conducted <u>when it is determined that the form includes the input field</u>.

Further, as discussed above, Bradley <u>even</u> fails to disclose the claimed determination unit that determines whether the accessed web page includes an input field.

Thus, Bradley fails to disclose the second print controller which controls the printing unit to print an image data having a fill-in area corresponding to the input field when the

determination unit determined that the web page includes the input field, as recited in claims 1, 8, 16, 17, 18 and 20.

Accordingly, Wolff and Bradley, either alone or in combination, fail to disclose or to have rendered obvious the above claimed feature.

Thus, claims 1, 8, 16, 17, 18 and 20 are patentable over Wolff and Bradley. Further, claims 6, 7, 14, 15 and 23-27 are patentable for at least the same reasons, as well as for the additional features they recite. Applicants respectfully request withdrawal of the rejection.

Claims 2-5 and 10-13 are rejected under 35 U.S.C. §103(b) as being unpatentable over Wolff in view of Bradley and U.S. Patent Publication No. 2003/0093378 (Silverbrook). Applicants respectfully traverse the rejection.

This rejection is premised upon the presumption that the combination of Wolff and Bradley discloses, teaches or suggests the above features of claims 1 and 8. As discussed above, Wolff and Bradley fail to disclose, teach or suggest at least these features. Further, Silverbrook fails to make up for the deficiency of Wolff and Bradley. Thus, the rejection is improper. Applicants respectfully request withdrawal of the rejection.

In view of at least the foregoing, Applicants respectfully submit that this application is in condition for allowance. Applicants earnestly solicits favorable reconsideration and prompt allowance of the pending claims.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, Applicants invite the Examiner to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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